



P/3968-12

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Date: November 3, 2004

Peter Kassan

Group Art Unit: 2141

Serial No.: 10/671,194

Examiner: Unassigned

Filed: September 25, 2003

For: **SYSTEM FOR PRODUCING ON-LINE CONTENT FROM WEB SITES ON DEMAND**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

**PETITION TO MAKE NEW APPLICATION
SPECIAL UNDER 37 C.F.R. §1.102 AND MPEP §708.02 VIII**

Sir:

Applicant petitions pursuant to 37 C.F.R. §1.102 and M.P.E.P. §708.02(VIII), to make the attached application entitled **SYSTEM FOR PRODUCING ON-LINE CONTENT FROM WEB SITES ON DEMAND** special so that said application can be examined out of turn. The basis of this petition is the presence of at least one actual infringing system on the market which infringes at least some of the claims in the application.

1. **Claims:**

- (a) All of the claims in this case are directed to a single invention.
- (b) If the Office determines that all the claims presented are not directed to a single invention, applicant will make an election, without traverse, as a prerequisite to the grant of special status.

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2. Search:

A search was made in the U.S. Patent and Trademark Office Internet database on class 705, subclasses 1, 16, 26, 27, and on class 709, subclasses 201, 203 and 246. Keyword searching was also utilized to augment the search.

3. Copies of References:

Copies of the patents uncovered and deemed most clearly related to the subject matter encompassed by the claims are submitted herewith. These references are:

<u>U.S. Patent No.</u>	<u>Inventor</u>
6,213,703	Garrido
<u>Publication No.</u>	<u>Inventor</u>
2003/0069811 A1	Ximenes et al.
2002/0026379 A1	Chiarabini et al.
2002/0095350 A1	Taguchi
2001/0027419 A1	Sands

4. Discussion of References:

U.S. Patent No. 6,213,703 to Garrido ("Garrido")

This patent provides for an Electronic Bookstore Vending Machine. A customer can browse through an electronic catalog of books using his home computer via the Internet, or by means of user interaction means 6 provided at one of a plurality of electronic bookstores (ESBs) 2. Central distribution unit (CDU) 1 links to a plurality computers 3 belonging to various authors and publishers as well as the plurality of ESBs 2, and provides hosting of the electronic catalog. Should the customer decide to purchase a particular title, the computer of corresponding author or publisher releases the electronic text to CDU 1 which then redirects the text file to one of the ESBs indicated by the customer. The selected ESB prints a hard copy of the selected title that the customer can pick up (see column 5, line 64 through column 7, line 28).

Applicant maintains that the Garrido reference fails to teach or suggest the invention as claimed in Applicant's above-identified patent application.

Turning to independent claim 1 of the present application, claim 1 recites a method for providing printed pages of web hosted information in response to an electronic request received over a communication network. The method of claim 1 comprises providing add-in software operable with a web site that enables a visitor of the web site to submit a request for receiving a printed copy of web hosted information that is displayable as web pages. The method further comprises receiving electronic order information representing the request, processing the electronic order information to provide electronic production information representing instructions for fulfilling the request, transmitting the electronic production information to a fulfillment facility, and providing to the visitor the requested web hosted information from the fulfillment facility in the form of printed pages.

Garrido, in contrast, fails to teach or suggest all of the elements of this method. More particularly, Garrido does not teach or suggest add-in software operable with a web site, nor does it teach or suggest processing electronic order information to provide electronic production information that represents instructions for fulfilling a request for a printed copy of web hosted information. Garrido teaches, instead, a typical prior art on-demand delivery system in which a user identifies a text file to be printed.

Similarly, independent claims 28 and 29 are distinguishable over Garrido because of features discussed above with regard to independent claim 1. Applicant maintains that Garrido fails to teach or suggest the features identified in these claims for the same reason as identified above with respect to claim 1.

Therefore, for the reasons set forth Applicant submits, in accordance with 37 CFR 1.111(b) and (c) and MPEP §708.02VIII(E) that the portions in the claims that patentably distinguish the invention from the Garrido reference are specifically identified .

U.S. Patent Application Publication 2003/0069811 to Ximenes et al. (“Ximenes”)

The patent application publication to Ximenes et al. provides for an On Demand Reproduction of Visual Images. Catalog server 103 hosts catalog 108 of visual images that can be browsed by patron 121 using portal 106, such as a web browser. If desired, the patron can identify a particular image in the catalog and place an order by providing payment information to ordering server 104. Upon receipt of payment, ordering server 104 provides print file 105 associated with the desired image to print facility 107. The print file provides the necessary information needed for the print facility to reproduce the desired image. Upon completion of printing, the print facility delivers the reproduction to the patron (see paragraphs 20 and 21).

Applicant submits that, unlike the present invention, the invention disclosed in Ximenes does not regard add-in software that is operable with an Internet web site. Instead, a user operates a portal, such as a common web browser software application, and browses a pre-assembled catalog that, unlike applicant’s invention, includes an inventory of images. Applicant’s invention, in contrast, is operable, via add-in software, with a web site to enable a visitor to order a printed copy of web hosted information.

Similarly, independent claims 28 and 29 are distinguishable over Ximenes because of features discussed above with regard to independent claim 1. Applicant maintains that Ximenes fails to teach or suggest the features identified in these claims for the same reason as identified above with respect to claim 1.

Therefore, for the reasons set forth Applicant submits, in accordance with 37 CFR 1.111(b) and (c) and MPEP §708.02VIII(E) that the portions in the claims that patentably distinguish the invention from the Ximenes reference are specifically identified .

U.S. Patent Application Publication 2002/0026379 A1 to Chiarabini et al. (“Chiarabini”)

The patent application publication to Chiarabini provides a Method and Apparatus for Automated On-Line Printing Service. In an on-demand book purchasing method, a potential

customer visits home page 20 where books to be sold are presented. After a customer selects a title, the content 32, including text and graphics, of the book is displayed in screen 30. The displayed content may include disclosure of the complete text of the book. A user may elect to purchase a hard-copy of the book by clicking buy button 24. Upon completion of the customer order, a print request is sent to a vendor who then prints a new copy of the book with a predetermined format based on stored electronic information about the book. The printed book is then delivered to the customer by mail or other delivery service (see paragraphs 12-15, and 18).

Applicant submits that Chiarabini does not disclose the combination of elements of applicant's claim 1. More particularly, Chiarabini discloses a print on demand service in which books to be sold are presented via an Internet web site. Chiarabini does not teach or suggest additional software that is operable within a web site that enables a visitor of the web site to submit a request and receive a printed copy of web hosted information. Instead, Chiarabini provides an interface that enables user to select images and/or books from a catalog, and then order a hard copy of an image and/or book. Applicant submits that the processes disclosed in Chiarabini, particularly with respect to enabling a selection from a catalog of titles, is distinct from applicant's claim 1.

Similarly, independent claims 28 and 29 are distinguishable over Chiarabini because of features discussed above with regard to independent claim 1. Applicant maintains that Chiarabini fails to teach or suggest the features identified in these claims for the same reason as identified above with respect to claim 1.

Therefore, for the reasons set forth Applicant submits, in accordance with 37 CFR 1.111(b) and (c) and MPEP §708.02VIII(E) that the portions in the claims that patentably distinguish the invention from the Chiarabini reference are specifically identified .

U.S. Patent Application Publication 2002/0095350 to Taguchi (“Taguchi”)

The patent application publication to Taguchi provides for an On Demand Book Purchasing Method. One or more customers using customer terminals 104 may browse image content offered by retailer computer entities 102 and 103 through a web site. Print merchant computer entity 100 provides a printing service for the content retailers in which the print merchant fulfills orders placed by customers on the retailer web sites. The print merchant provides the order information to one of a plurality of print service providers 105-107 that physically print the image content and then deliver it to the customer using one of a plurality of courier service providers 117-119 (see paragraphs 58-63).

Applicant submits that Taguchi does not teach or suggest all of the features of applicant’s claim 1. More particularly, Taguchi does not disclose add-in software that is operable with a web site and that enables a visitor of the web site to submit a request for receiving a printed copy of web hosted information that is displayable as web pages. Instead, Taguchi teaches a method for print on demand of content that is provided, for example, by retailer web sites.

Similarly, applicant’s independent claims 28 and 29 are distinguishable over Taguchi because of features discussed above with regard to independent claim 1. Applicant maintains that Taguchi fails to teach or suggest the features identified in these claims for the same reason as identified above with respect to claim 1.

U.S. Patent Application Publication 2001/0027419 to Sands (“Sands”)

The patent application publication to Sands provides for a Method and Apparatus for fulfilling Electronic Book Orders on Demand. Book publishers supply electronic book content to printing facilities that receive book orders from order sources as retail websites and/or retail stores. Books are “built when ordered” via the Internet and comprise content from book publishers. The books are printed, bound and packaged using material unique to the order source, and shipped directly to the reader who initiated the book order.

Applicant respectfully submits that Sands teaches the production of pre-formatted books on-demand, and does not teach or suggest elements of applicant's claim 1. In contrast with applicant's claim 1, Sands does not disclose add-in software that is operable with a web site that enables a visitor of the web site to submit a request for receiving a printed copy of web hosted information that is displayable as web pages. Instead, Sands teaches that printed content originates from a book publisher 107 which supplies electronic book content to a printing facility 105. Applicant respectfully submits this is patentably distinct from applicant's claim 1 that defines providing a printed copy of web hosted information that is displayable as web pages.

Similarly, applicant's independent claims 28 and 29 are distinguishable over Sands because of features discussed above with regard to independent claim 1. Applicant maintains that Sands fails to teach or suggest the features identified in these claims for the same reason as identified above with respect to claim 1.

Therefore, for the reasons set forth Applicant submits, in accordance with 37 CFR 1.111(b) and (c) and MPEP §708.02VIII(E) that the portions in the claims that patentably distinguish the invention from the Sands reference are specifically identified .

5. Fee:

Enclosed is the required fee of \$130.00 (Check No. 18605).

In the event the actual fee is greater than the payment submitted or is inadvertently not enclosed or if any additional fee during the prosecution of this application is not paid, the Patent Office is authorized to charge the under-payment to Deposit Account No. 15-0700.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 3, 2004:

Max Moskowitz

Name of applicant, assignee or
Registered Representative

Signature

November 3, 2004

Date of Signature

MM:JJF:ck

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Respectfully submitted,

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